

Response dated: December 18, 2009  
App. No. 10/658,449; Filed: September 9, 2003  
Response to Office Action of June 18, 2009

### **REMARKS**

Claims 1-20, 22, and 24-27 were pending in this application. By this response, claim(s) 1, 4, 5, 7-18, 20, 22, and 24 have been amended. Claims 2, 3, 6, and 19 have been canceled. As a result of a previous restriction requirement, claims 25-27 have been withdrawn. No new matter has been added. Cancellation or amendment of the claims is not to be considered a dedication to the public of any subject matter.

Thus, claims 1, 4, 5, 7-18, 20, 22, and 24 are currently under consideration. Reconsideration of these claims is requested in view of the amendments and the following remarks.

### **INFORMATION DISCLOSURE STATEMENTS**

Applicants note that references submitted in Information Disclosure Statements dated 9/9/2003, 11/3/2004, 11/4/2004, and 3/8/2005 remain unacknowledged. It is respectfully requested that these Information Disclosure Statements be considered and the PTO Forms 1449 be initialed and returned with the next Action.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 112**

#### **Claims 2-7, 19, and 20**

Claims 2-7, 19, and 20 currently stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 3, 6, and 19 have been canceled. Claims 4, 5, 7, and 20 have been amended to overcome the Examiner's rejections.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 102**

#### **Claims 1-8, 10, 18, 19, 20, 22, and 24**

Claims 1-8, 10, 18, 19, 20, 22, and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by any of U.S. 5,314,486 to Zang et al. ("Zang"), U.S. 4,693,722 to William H. Wall

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(“Wall”), U.S. 4,778,472 to Homsy et al. (“Homsy”), and U.S. 4,917,701 to Douglas H. Morgan (“Morgan”). Applicants note that the Office Action indicates that the rejection is over U.S. 4,633,722 to Wall. U.S. 4,633,722 belongs to Beardmore; applicants take the rejection to be under 4,693,722 to Wall. In order for Applicants’ claims to be anticipated by any of Zang, Wall, Homsy, or Morgan, each reference must disclose, either expressly or inherently, each and every element of the claimed invention.

Independent claim 1 currently recites, in part, a spinal prosthesis, comprising a first prosthesis body sized, shaped, and oriented to span the distance between a first pedicle of a vertebral body and a first inferior articular process on the opposite side of the vertebral body from the first pedicle, a second prosthesis body sized, shaped, and oriented to span the distance between a second pedicle of the vertebral body and a second inferior articular process on the opposite side of the vertebral body from the second pedicle, a fastening element coupled to each of the first and second prosthesis bodies, the fastening elements configured to be installed within the vertebral body at or near the first and second pedicles; and an artificial facet joint structure carried by each of the first and second prosthesis bodies at locations spaced from the fastening elements.

Zang discloses a prosthetic replacement device for a metatarso-phalangeal joint. The Zang prosthetic includes a convex bearing surface having a stem configured to be received in the resected metatarsal bony shaft, and a concave bearing surface having a stem configured to be received within the resected phalangeal bony shaft.

Zang does not anticipate claim 1 as Zang does not disclose, either expressly or inherently, each and every claim limitation of claim 1. For example, Zang does not disclose (1) a first prosthesis body sized, shaped, and oriented to span the distance between a first pedicle of a vertebral body and a first inferior articular process on the opposite side of the vertebral body from the first pedicle, and (2) a second prosthesis body sized, shaped, and oriented to span the distance between a second pedicle of the vertebral body and a second inferior articular process on the opposite side of the vertebral body from the second pedicle. Claim 1 has been amended to further clarify that the structure of the first and second prosthesis bodies are sized, shaped, and

oriented to span the distance between a pedicle of a vertebral body and an inferior articular process on the opposite side of the vertebral body. Zang does not disclose this structure.

Wall discloses a prosthetic device for a temporomandibular joint. The Wall prosthetic includes a pair of plates that are clamped about the ramus of the mandible, and a convex bearing surface that receives one of the plates to form a condyle.

Wall does not anticipate claim 1 as Wall does not disclose, either expressly or inherently, each and every claim limitation of claim 1. For example, Wall does not disclose (1) a first prosthesis body sized, shaped, and oriented to span the distance between a first pedicle of a vertebral body and a first inferior articular process on the opposite side of the vertebral body from the first pedicle, and (2) a second prosthesis body sized, shaped, and oriented to span the distance between a second pedicle of the vertebral body and a second inferior articular process on the opposite side of the vertebral body from the second pedicle. Claim 1 has been amended to further clarify that the structure of the first and second prosthesis bodies are sized, shaped, and oriented to span the distance between a pedicle of a vertebral body and an inferior articular process on the opposite side of the vertebral body. Wall does not disclose this structure.

Homsy discloses a prosthetic device for a temporomandibular joint. The Homsey prosthetic includes a first part which replaces the natural glenoid fossa and articular eminence of a natural TM joint, and a second part which replaces the natural condylar head.

Homsy does not anticipate claim 1 as Homsey does not disclose, either expressly or inherently, each and every claim limitation of claim 1. For example, Homsey does not disclose (1) a first prosthesis body sized, shaped, and oriented to span the distance between a first pedicle of a vertebral body and a first inferior articular process on the opposite side of the vertebral body from the first pedicle, and (2) a second prosthesis body sized, shaped, and oriented to span the distance between a second pedicle of the vertebral body and a second inferior articular process on the opposite side of the vertebral body from the second pedicle. Claim 1 has been amended to further clarify that the structure of the first and second prosthesis bodies are sized, shaped, and oriented to span the distance between a pedicle of a vertebral body and an inferior articular process on the opposite side of the vertebral body. Homsey does not disclose this structure.

Morgan discloses a prosthetic device for a temporomandibular joint. The Morgan prosthetic is similar to the Wall prosthetic in that it includes a plate that is formed to the ramus of the mandible, and an artificial condyle.

Morgan does not anticipate claim 1 as Morgan does not disclose, either expressly or inherently, each and every claim limitation of claim 1. For example, Morgan does not disclose (1) a first prosthesis body sized, shaped, and oriented to span the distance between a first pedicle of a vertebral body and a first inferior articular process on the opposite side of the vertebral body from the first pedicle, and (2) a second prosthesis body sized, shaped, and oriented to span the distance between a second pedicle of the vertebral body and a second inferior articular process on the opposite side of the vertebral body from the second pedicle. Claim 1 has been amended to further clarify that the structure of the first and second prosthesis bodies are sized, shaped, and oriented to span the distance between a pedicle of a vertebral body and an inferior articular process on the opposite side of the vertebral body. Morgan does not disclose this structure.

As such, Zang, Wall, Homsy, and Morgan do not disclose, either expressly or inherently, each and every claim limitation of independent claim 1. Claims 4, 5, 7, 10, 18, 20, 22, and 24 depend from claim 1 and are not anticipated by Zang, Wall, Homsy, and Morgan for at least the same reasons set forth above. Applicants respectfully request the rejections to claims 1, 4, 5, 7, 10, 18, 20, 22, and 24 be withdrawn.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

#### **Claims 8 and 10-17**

Claims 8 and 10-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zang as applied to claim 1 above, and further in view of U.S. 4,955,916 to Carignan et al. (“Carignan”).

Claims 8 and 10-17 depend from claim 1 and therefore include all of the limitations of those claims. Carignan fails to disclose or suggest features of claim 1 that are lacking in Zang, such as the structure of the first and second prosthesis bodies being sized, shaped, and oriented to span the distance between a pedicle of a vertebral body and an inferior articular process on the opposite side of the vertebral body. The combination of Zang and Carignan therefore cannot

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render claims 8 and 10-17 obvious. Claims 8 and 10-17 are patentable over Zang and Carignan under § 103(a).

Claim 9 currently stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Zang as applied to claim 1 above, and further in view of U.S. 5,314,492 to Hamilton et al. (“Hamilton”).

Claim 9 depends from claim 1 and therefore includes all of the limitations of those claims. Hamilton fails to disclose or suggest features of claim 1 that are lacking in Zang, such as the structure of the first and second prosthesis bodies being sized, shaped, and oriented to span the distance between a pedicle of a vertebral body and an inferior articular process on the opposite side of the vertebral body. The combination of Zang and Hamilton therefore cannot render claim 9 obvious. Claim 9 is patentable over Zang and Hamilton under § 103(a).

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### CONCLUSION

In light of the remarks set forth above, Applicants respectfully request the Examiner expedite the prosecution of this patent application to issuance. If it is determined that a telephone conference would aid in the prosecution of this application, the Examiner is invited to telephone the undersigned at (650) 287-2163.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 50-4050 referencing docket no. 10002-701.407. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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